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| EXAMINER | |
| ULM, J | |
| ART UNIT | PAPER NUMBER |
| 1812 | 16 |

DATE MAILED:

10/29/92

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run 4 mos or continues to run _____ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 10/9/92 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
 - c. ☐ They raise the issue of new matter. (See Note).
 - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☐ Upon the filing an appeal, the proposed amendment ☐ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: _____
Claims objected to: _____
Claims rejected: _____

However;

☐ Applicant's response has overcome the following rejection(s): _____

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because: see attached communication

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

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THE PERIOD FOR RESPONSE IS EXTENDED TO RUN FOUR MONTHS FROM THE DATE OF THE FINAL REJECTION. Any extension of time must be obtained by filing a petition under 37 C.F.R. § 1.136(a) accompanied by the proposed response and the appropriate fee. 5 The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee.

10 The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 27 to 38 are pending in the instant application with claims 1 to 26 and 39 to 46 having been canceled.

15 Claims 27 to 38 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Cousens et.al. patent in view of the Cohen et.al. patent for reasons of record.

20 The Cousens et.al. patent is prior art to claims 27 to 38 of the instant application under 35 U.S.C. § 102(e) because, under 35 U.S.C. § 120, it has benefit of parent application 06/717209, filed 28 March of 1985, for those elements common to both applications. Application 06/717209 describes the construction of the recombinant vector pYS12 which encodes a fusion protein containing a leader peptide (hSOC) joined to a target peptide (proinsulin) by a cysteine-free hinge region and a cleavage site (-Lys-Arg-Ser-Thr-Ser-Thr-Ser-) and further describes the 25 expression and cleavage of the encoded product. The Cousens

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et.al. patent, therefore, has benefit of the 28 March 1985 filing date for those element upon which it was depended for this rejection.

5 The declaration filed on 9 October of 1992 under 37 C.F.R. § 1.131 has been considered but is ineffective to overcome the Cousens et.al. reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country prior to the effective date of the Cousens et.al. reference.

10 Applicant's arguments filed 9 October of 1992 have been fully considered but they are not deemed to be persuasive.

Any inquiry concerning this communication should be directed to John D. Ulm at telephone number (703) 308-4008.

Robert J. Hill, Jr.
ROBERT J. HILL, JR.
PRIMARY EXAMINER
ART UNIT 1812